

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Marco FILICORI

Title: UNITARY COMBINATIONS OF FSH AND hCG

Patent No.: 7,985,732 Application No.: 10/559,610

Issue Date: 07/26/2011 Filing Date: 01/31/2006

Examiner: Regina M. Deberry

Art Unit: 1647

Confirmation 1532

Number:

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Patentee respectfully requests reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent upon grant of the patent. This is not a Request for Reconsideration of the PTA Decision mailed June 20, 2011, and so is timely filed within two months of the patent's issue date.

The patent was granted with 0 days PTA. In contrast, Patentee has determined that the patent is entitled to 256 days of PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

An analysis of the PTA information on PAIR indicates that the PTO's determination is based on two errors: (i) a double correction of the error already corrected after the PTA Decision mailed June 20, 2011 and (ii) the use of an erroneous date as the commencement date for the three-year, "B" delay period. These are explained in more detail below.

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(i) Double Correction Of The PTO's Original Error

A Request for Reconsideration of the PTA indicated in the Notice of Allowance was filed with the Issue Fee payment, and a Decision was mailed June 20, 2011. Patentee agrees with the Decision in as much as it corrected the date that a Request for Continued Examination (RCE) was filed (from March 19, 2009 to March 19, 2010). Although the Request for Reconsideration also raised the issue of "B" delay, that aspect of the Request was dismissed as premature.

According to the Decision, the error in the RCE filing date had led to an erroneous award of 64 days of Patent Office delay that was reflected in the PTA award indicated in the Notice of Allowance. Thus, the Decision indicates that a deduction of 64 days was being made from the award indicated in the Notice of Allowance, resulting in an award at that time of 0 days. (That Decision still did not take into account "B" delay, because the patent did not grant until July 26, 2011, after the Decision was issued.)

The PTA information currently on PAIR indicates that this error has been corrected twice, resulting in a net deduction of 64 days PTA, which deduction is not appropriate, rather than a net zero-ing out of the original erroneous 64 day award.

As set forth in the Decision, a 64 day deduction was required to correct the PTA as calculated when the RCE was improperly recorded as having been filed on March 19, 2009. The PTA information on PAIR has corrected the underlying problem—the RCE is now correctly recorded as having been filed on March 19, 2010. Thus, no further corrective deduction of PTA is required to correct this error, because the underlying error already has been corrected. That is, now that the RCE filing date is properly recorded, there is no improper award of 64 days PTA that needs to be corrected by a corresponding deduction.

Thus, the -64 days PTO Manual Adjustment is improper and should be removed.

(i) Erroneous Commencement Date For Three-Year "B" Delay

The PTA information currently on PAIR indicates that the Patent Office used December 4, 2006 as the "Commencement Date" to calculate the three-year, B delay for the three erroneous date as the starting date for the three-year, "B" delay period. This date is completely erroneous, and unrelated to any relevant date for the patent.

The patent issued from a U.S. national stage application of International Application PCT/IB2004/001813, which claimed priority to U.S. patent application 10/452,926, filed June 3, 2003. In accordance with 37 CFR § 1.703(b), the “Commencement Date” should be the date on which the national stage commenced:

the period of adjustment is the number of days, if any, in the period beginning on the date after the date that is three years after the date on which the application was filed under 35 USC §111(a) or the national stage commenced under 35 USC §371(b) or (f) in an international application and ending on the date a patent was issued.

As set forth in 35 USC §371(b):

Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22 (1) or (2), or under article 39 (1)(a) of the treaty,

(35 USC §371(f) relates to early national stage processing and does not apply here.)

The national stage commenced for the underlying application here on December 5, 2005 (the expiration of the time limit under 35 USC §371(b) was actually December 3, 2005, which was a Saturday, thus the Commencement Date was the following Monday, December 5, 2005). Thus, December 5, 2005 is the Commencement Date for the three-year, “B” delay calculation. The December 5, 2006 date indicated in the PTA information on PAIR does not correspond to any relevant action taken in the underlying application, and may have resulted from a clerical error in data entry (e.g. entering 2006 instead of 2005).

When the correct Commencement Date is used, the total “B” delay amounts to 468 days, running from December 5, 2005 until the day before the RCE was filed on March 19, 2010 (as shown on the attached sheet).

Taking all of the non-overlapping Patent Office delay into account (e.g., the “A” delay and the “B” delay) results in a total Patent Office delay of 682 days. Deducting the 426 days charged for Applicant results in a total PTA award of 256 days of PTA.

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B): 682 days

(b) Total Applicant delay: 426 days

Final PTA Determination: 256 days

Patentee therefore respectfully requests that the patent be accorded 256 days PTA.

The patent is not subject to a terminal disclaimer.

Patentee believes no fee is due with this Request. However, the Commissioner is authorized to charge any fees which may be due to Deposit Account No. 19-0741.

Respectfully submitted,

Date September 7, 2011

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